

## **REMARKS/ARGUMENTS**

### **Status of Claims**

Claims 1-68 remain in this application.

A Preliminary Amendment is being filed under separate cover in which claims 6, 8-10, 47, 48, 53, 54 and 56-58 have been amended and claims 65-72 have been added.

### **Restriction Requirement Under 35 U.S.C. 121**

Examiner alleges that the claims of the present application contain a plurality of inventions and has separated the claims into 16 groups. Examiner requires that only one of the groups be elected. Applicant provisionally elects Group II, with traverse.

Examiner indicates at page 5 of the Action that “[s]hould Invention II be elected, Applicant is required to select one nucleotide sequence from SEQ ID NO:4 or SEQ ID NO:11”, and further indicates that “[t]his is not species election”. Applicant provisionally selects SEQ ID NO:4, with traverse. Applicant submits that SEQ ID NO:4 and NO:11 are functionally similar as both are involved in spermatozoa development. Furthermore, both sequences are similar as shown by the sequence alignment in Figure 4B. SEQ ID NOs:4 and 11 are variant sequences obtained from different species (bull and human, respectively) which are both encompassed by generic claims 8 and 53. Accordingly, SEQ ID NO:4 and SEQ ID NO:11 should be examined within the same application.

Furthermore Examiner’s election requirement in this regard amounts to a species election despite the Examiner’s statement to the contrary. Such a species election is in direct contravention of 37 CFR 1.141 which states “that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application”. Accordingly, Applicant submits that claims to both SEQ ID NO:4 or SEQ ID NO:11 should be retained in the application, and reconsideration and withdrawal of this requirement is respectfully requested.

At page 8 of the Office Action, Examiner indicates that the restriction requirement is proper based on different classifications associated with the proposed claim groupings. However, review of Examiner’s description of the 16 individual groupings from page 2 to page 5 of the Action, indicates that the classification of many of the claim groupings belong in the same class and subclass. Examiner’s claim groupings are summarized in the following Table:

<b>Group Number</b>	<b>Claim Number</b>	<b>Class/Subclass</b>
Group I	Claims 1-7, 16-18, 22, 36, 46, 47, 49, 50, 52, 54, 55, 59, 63, 64	<ul style="list-style-type: none"> <li>• 530/350</li> <li>• 514/2</li> </ul>
Group II	Claims 8-15, 48, 53, 60-62	<ul style="list-style-type: none"> <li>• 536/23.5</li> <li>• 435/320.1, 325</li> </ul>
Group III	Claims 19-21, 22 (in part)	<ul style="list-style-type: none"> <li>• 530/387.1</li> </ul>
Group IV	Claim 22 (in part)	<ul style="list-style-type: none"> <li>• 514/2</li> </ul>
Group V	Claim 23	<ul style="list-style-type: none"> <li>• 530/350</li> <li>• 514/2</li> </ul>
Group VI	Claims 24, 44, 56	<ul style="list-style-type: none"> <li>• 530/350</li> <li>• 514/2</li> </ul>
Group VII	Claims 25-27, 57	<ul style="list-style-type: none"> <li>• 530/350</li> <li>• 514/2</li> </ul>
Group VIII	Claims 29, 51	<ul style="list-style-type: none"> <li>• 530/350</li> <li>• 514/2</li> </ul>
Group IX	Claims 29, 58	<ul style="list-style-type: none"> <li>• 530/350</li> <li>• 514/2</li> </ul>
Group X	Claim 30	<ul style="list-style-type: none"> <li>• 530/350</li> <li>• 514/2</li> </ul>
Group XI	Claims 31, 32	<ul style="list-style-type: none"> <li>• 530/387.1</li> </ul>
Group XII	Claim 33	<ul style="list-style-type: none"> <li>• 530/356</li> <li>• 514/2</li> </ul>
Group XIII	Claims 34, 35	<ul style="list-style-type: none"> <li>• 435/69.7</li> </ul>
Group XIV	Claims 37, 38	<ul style="list-style-type: none"> <li>• 530/350</li> <li>• 514/2</li> </ul>
Group XV	Claims 39, 40, 41	<ul style="list-style-type: none"> <li>• 530/350</li> <li>• 514/2</li> </ul>
Group XVI	Claims 42, 43, 45	<ul style="list-style-type: none"> <li>• 800/8</li> </ul>

The Table clearly shows that Examiner's classification of Group I, V, VI, VII, VII, IX, X, XII, XIV and XV are the same, each having a proposed classification of class 530, subclass 350 and class 514, subclass 2. Group III and Group XI also have the same proposed classification scheme of class 530, subclass 387.1. Accordingly, Examiner's contention that the inventions "have acquired a separate status in the art as shown by their different classifications" is unclear, and the grounds for the restriction requirement remain questionable.

Applicant therefore disagrees with the requirement for restriction, and respectfully requests reconsideration and withdrawal of the requirement under 37 CFR 1.143.

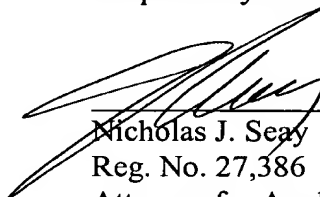
In the event that the restriction requirement becomes final, Applicant wishes to specifically argue for the retention of claims 42 and 43 as originally filed as these claims

recite a gene encoding PT32, and the search for this subject matter will be no more extensive than the search required for claim 14, which Examiner concedes as being included in Invention II.

Applicant further submits that new claims 65-72 (added in a Preliminary Amendment filed under separate cover) should be retained since each of these claims ultimately depend from claim 8 which Examiner concedes as belonging in Invention II. These new claims will not require a further search over and above the search done to examine claim 8, as establishing novelty and inventiveness of claim 8 over cited prior art will necessarily establish the novelty and inventiveness of the new claims by virtue of dependency.

It is respectfully submitted that the above-identified application is now in a condition for allowance and favourable reconsideration and prompt allowance of these claims are respectfully requested. Should the Examiner believe that anything further is desirable in order to place the application in better condition for allowance, the Examiner is invited to contact the Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



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